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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,515	04/25/2005	Arthur Dybevik	1935-00158	8697

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ANDRUS, SCEALES, STARKE & SAWALL, LLP  
100 EAST WISCONSIN AVENUE, SUITE 1100  
MILWAUKEE, WI 53202

EXAMINER

COLLINS, GIOVANNA M

ART UNIT PAPER NUMBER

3672

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/532,515	<b>Applicant(s)</b> DYBEVIK ET AL.	
	<b>Examiner</b> Giovanna M. Collins	<b>Art Unit</b> 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 8-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/1/05, 4/25/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

#### ***Claim Objections***

1. Claims 1, 4-5 and 8-14 are objected to because of the following informalities:

Claim 1 recites the transitional phrase "characterized in the packer consists of".

This transitional phrase does not conform with standard US practice. Furthermore, in US practice the phrase "consists of" excludes any element, step, or ingredient not specified in the claim, in other words is not inclusive. It is not clear whether the applicant desires the claims to be inclusive or not. Therefore, for examination purposes the examiner will assume the applicant intended for the claims to be inclusive.

The same objection applies to claims 4-5.

In line 2 of claim 1, the applicant recites "past this". In this phrase, it is unclear whether the applicant is referring to the packer or the pipe string.

Claim 1 recites the limitation "the operating position" in line 4. There is insufficient antecedent basis for this limitation in the claim as this limitation has not been previously recited.

Claim 1 recites the limitation "the fitting surface" in lines 5-6. There is insufficient antecedent basis for this limitation in the claim as this limitation has not been previously recited.

In line 7 of claim 1, the phrases "a slot" and "a line" should be changed to -- the slot -- and -- the line --, respectively.

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Claim 8-14 should using verbal nouns or gerunds when discloses the method steps. For example, in line 5 of claim 8, the applicant should recite - - connecting or constructing an inner packer ring at each packer position along the pipe string - -.

In claim 8 and 11-14, the word "if" in line 22 renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

The same objection applies to claims 11-14.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Lembcke et al. 6173788.

Lembcke discloses (fig. 1) an external packer arranged to lead at least one line past having a continuous inner packer ring (tubular on inside of element 12), and a separate and continuous outer packer ring (12) which in operation position is placed outside the inner packer ring enclosing this in a pressure tight manner and a fitting

surface ( closest to the casing of on of the packer rings (10) is provided with a slot (14) which encloses a line in a pressure tight manner when in the operating position.

Referring to claim 2, Lembcke discloses the inner packer ring (inner tubular) is a separate packer unit from other well tools.

Referring to claim 3, Lembcke disclose the packing ring (inner tubular) is integration as an external ring portion of a pipe in the pipe string.

Referring to claim 4, Lembcke discloses the inner packer ring (inner tubular have several annular packer component (tubing used to make of the production string) which are fitted together and function as the inner packer ring.

4. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Neely et al. 4619384.

Neely discloses (fig. 2) an external packer arranged to lead at least one line past having a continuous inner packer ring (16), and a separate and continuous outer packer ring (30) which in operation position is placed outside the inner packer ring enclosing this in a pressure tight manner and a fitting surface is provided with a slot (when packer encloses around cable in fluid tight manner a slot is formed) which encloses a line in a pressure tight manner when in the operating position.

Referring to claim 2, Neely discloses the inner packer ring (16) is a separate packer unit from other well tools.

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Referring to claim 3, Neely disclose the packing ring (16) is integration as an external ring portion of a pipe in the pipe string.

Referring to claim 4, Neely discloses the inner packer ring (16) have several annular packer component (tubing used to make of the production string) which are fitted together and function as the inner packer ring.

Referring to claim 5, Neely discloses the outer packer ring (30) have several annular packet components ( see col. 4, lines 30-33, parts to mechanical set the packer) that are fitted together and function as the outer packer ring.

Referring to claims 6-7, Neely discloses the packer components (of retractable packer 30) are assembled in axial direction or radial direction.

### ***Allowable Subject Matter***

Claim 8 would be allowable if rewritten or amended to overcome the objections, set forth in this Office action.

Claims 9-14 would be allowable if rewritten to overcome the objections, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna M. Collins whose telephone number is 571-272-7027. The examiner can normally be reached on 6:30-3 M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
gmc

  
**David Bagnell**  
**Supervisory Patent Examiner**  
**Technology Center 3670**